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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/540,648	03/31/2000	Paul G. Skuriat	20558-011	1725

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EXAMINER
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COLBERT, ELLA

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 04/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/540,648

Applicant(s)

SKURIAT ET AL.

Examiner

Ella Colbert

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. Claims 1-8 and 10 are pending. Claim 1 has been amended in this communication filed 11/03/04 entered as Response After Non-Final Action.

#### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1, lines 6-9 recites "recording means for recording time of completion information ... one time of completion value representative of a time of completion from a start time, the time of completion value recorded when ...". This claim limitation is unclear and does not make sense. There appears to be some words omitted from the claim limitation.

#### ***Claim Objections***

4. Claim 10 is objected to because of the following informalities: page 6, line 9 recites "... by said trade management system:". This line would be better recited "... by said trade management system: and". Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by (US 5,297,031) Gutterman et al.

As per claim 1, Gutterman teaches, A system providing a measure of performance of participants to a trade management process, said trade management process including transmitting trade-related information between said participants, said system comprising: trade management processing means for receiving a first communication from a first participant to said trade management process (col. 2, lines 44-59); recording means for recording time of completion information including at least one time of completion value representative of a time of completion from a start times the time of completion value recorded when said first communication is received by said trade management processing means (col. 2, line 60-col. 3, line 67 and col. 5, lines 21-48); and performance processing means for generating a measure of performance with respect to said first participant as a function of said time of completion information the measure of performance being the time between the completion of steps in the trade management process (col. 4, lines 6-52 and col. 7, line 59 –col. 8, line 66).

As per claim 2, Gutterman teaches, A system according to claim 1 wherein said trade management processing means receives a plurality of communications from a said first participant to said trade management process (col. 9, lines 3-25); said recording means records time information including at least one time value representative of a time when at least two of said plurality of communications is received by said trade management processing means (col. 10, line 60-col. 11, line 68); and said performance processing means generates a measure of performance with

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respect to said first participant as a function of said time information for said at least two of said plurality of communications received by said trade management processing means (col. 12, lines 1-56).

As per claim 3, Gutterman teaches, A system according to claim 1 wherein said trade management processing means receives a second communication from a second participant to a second trade management process (col. 13, lines 27-46); said recording means records time information including at least one time value representative of a time when said communication is received by said trade management processing means (col. 13, line 47-col. 14, line 24); and said performance processing means generates a measure of performance of said second participant with respect to said first participant as a function of said time information (col. 14, lines 25-51).

As per claim 4, Gutterman teaches, A system according to claim 1 wherein said trade management processing means receives a second communication from a second participant to a second trade management process (col. 13, lines 27-46); said recording means records time information including at least one time value representative of a time when said second communication is received by said trade management processing means (col. 13, 47-col. 14, line 24); and said performance processing means generates a measure of performance of said second participant with respect to said first participant as a function of said time information (col. 14, lines 25-51).

***Claim Rejections - 35 USC § 103***

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7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 5-8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US 6247,000) Hawkins et al, hereafter Hawkins in view of (US 5,297,031) Gutterman et al, hereafter Gutterman.

As per claim 5, Hawkins teaches, A system providing a measure of performance of participants to a trade management process, said trade management process including transmitting trade-related information between said participants, said system comprising: a trade management system coupled to a network and adapted for receiving a first communication from a first participant to said trade management process (col. 8, line 64-col. 9, line 9, and fig.1). Hawkins failed to teach, a communication recording system coupled to said trade management system and adapted for recording time information including at least one time value representative of a time when said first communication is received by said trade management system and an information processing system coupled to said trade management system and adapted for generating a measure of performance with respect to said first participant as a function of said time information. Gutterman teaches, a communication recording system coupled to said trade management system and adapted for recording time information including at least one time value representative of time when said first communication is received by said trade management system (col. 13, line 47-col. 14, line 24); and an information processing system coupled to said trade management system and adapted for generating a measure of performance with respect to said first participant as a function of said time information for said at least two of said plurality of communications received by said trade management system (col. 14, lines 25-51). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have a communication recording system coupled to said trade management system and adapted for recording time information including at least one

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time value representative of time when said first communication is received by said trade management system and an information processing system coupled to said trade management system and adapted for generating a measure of performance with respect to said first participant as a function of said time information for said at least two of said plurality of communications received by said trade management system and to modify in Hawkins because such a modification would allow Hawkins to have information that could identify the order and the trader's account number and any special instructions.

As per claim 6, Gutterman teaches, A system according to claim 5 wherein said trade management system is adapted to receive a plurality of communications from a said first participant to said trade management process (col. 9, lines 3-25); said communication recording system is adapted for recording time information including at least one time value representative of a time when at least two of said plurality of communications is received by said trade management system (col. 10, line 60-col. 11, line 68); and said information processing system is adapted for generating a measure of performance with respect to said first participant as a function of said time information for said at least two of said plurality of communications received by said trade management system (col. 12, lines 1-56)

As per claim 7, Gutterman teaches, A system according to claim 5 wherein said trade management system is adapted to receive a second communication from a second participant to a second trade management process (col. 13, lines 27-46); said recording system is adapted for recording time information including at least one time



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value representative of a time when said communication is received by said trade management system (col. 13, line 47-col. 14, line 24); said information processing system is adapted for generating a measure of performance of said second participant with respect to said first participant as a function of said time information (col. 14, lines 25-51).

As per claim 8, Gutterman teaches, A system according to claim 5 wherein said trade management system is adapted to receive a second communication from a second participant to said trade management process (col. 13, lines 27-46); said information recording system is adapted for recording time information including at least one time value representative of a time when said second communication is received by said trade management system (col. 13, line 47-col. 14, line 24); and said information processing system is adapted for generating a measure of performance of said first participant and a measure of performance of said participant as a function of said time information (col. 14, lines 25-51).

As per claim 10, Hawkins teaches, A method of providing a measure of performance of participants to a trade management process, said trade management process including transmitting trade-related communications between said participants, said method comprising the steps of: providing a trade management system adapted for receiving said trade-related communications sent between said participants (col. 8, line 64-col. 9, line 9, and fig. 1). Hawkins failed to teach, receiving a first communication from a first participant to said trade management process; recording at least one time information when said first communication is received by said trade management

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system; generating a measure of performance with respect to said first participant as a function of said time information. Gutterman teaches, receiving a first communication from a first participant to said trade management process (col. 2, lines 44-59); recording at least one time information when said first communication is received by said trade management system (col. 13, line 47-col. 14, line 24); generating a measure of performance with respect to said first participant as a function of said time information (col. 14, lines 25-51). It would have been obvious to one having ordinary skill in the art at the time the invention was made to receiving a first communication from a first participant to said trade management process; recording at least one time information when said first communication is received by said trade management system; generating a measure of performance with respect to said first participant as a function of said time information and to modify in Hawkins because such a modification would allow Hawkins to have information that could identify the order and the trader's account number and any special instructions.

### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Martyn et al (US 6,195,647) disclosed a trading management system.

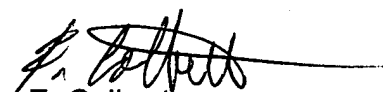
### ***Inquiries***

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 703-308-7064. The examiner can normally be reached on Monday-Thursday, 6:30AM-5:00PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703-308-1038. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
E. Colbert  
April 2, 2005